

**REMARKS**

Claims 1-3 and 6-8 are pending in this application. By this Amendment, claims 1 and 6 are amended to distinguish over the cited references, and claims 11 and 12 are canceled. No new matter is added by this Amendment. Support for the language added to claims 1 and 6 can be found in claims 11 and 12, respectively.

**I. Allowable Subject Matter**

Applicants note with appreciation that claims 3, 7 and 8 contain allowable subject matter.

**II. Rejections Under 35 U.S.C. §102(b)**

**A. Tanishiki**

Claims 1 and 6 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,180,908 ("Tanishiki"). This rejection is respectfully traversed.

Applicants point out that claims 1 and 6 have been amended to incorporate the subject matter recited in claims 11 and 12, respectively. As admitted by the Patent Office, Tanishiki does not teach or suggest these features. Specifically, Tanishiki does not teach or suggest that the discrete backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claims 1 and 6.

For the foregoing reasons, Applicants submit that Tanishiki does not teach or suggest all of the features recited in claims 1 and 6. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**B. Inoue**

Claims 1 and 6 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,393,292 ("Inoue"). This rejection is respectfully traversed.

Applicants point out that claims 1 and 6 have been amended to incorporate the subject matter recited in claims 11 and 12, respectively. As admitted by the Patent Office, Inoue does

not teach or suggest these features. Specifically, Inoue does not teach or suggest that the discrete backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claims 1 and 6.

For the foregoing reasons, Applicants submit that Inoue does not teach or suggest all of the features recited in claims 1 and 6. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**III. Rejections Under 35 U.S.C. §103(a)**

**A. Tanishiki in view of Tanaka**

Claim 2 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tanishiki in view of U.S. Patent No. 5,004,530 ("Tanaka"). This rejection is respectfully traversed.

Tanaka does not remedy the deficiencies of Tanishiki. Specifically, Tanaka does not teach or suggest that the discrete backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claim 1 .

For the foregoing reasons, Applicants submit that Tanishiki and/or Tanaka, in combination or alone, do not teach or suggest all of the features recited in claim 2. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**B. Inoue in view of Briffod**

Claims 11 and 12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Inoue in view of U.S. Patent No. 4,134,807 ("Briffod"). This rejection is respectfully traversed.

Claims 1 and 6 have been amended to incorporate the subject matter of claims 11 and 12, respectively.

The Patent Office alleges that Briffod teaches a backing member that abuts the entire breakthrough region, and that Inoue could have been adapted in view of Briffod to achieve the method and apparatus recited in claims 1 and 6. Applicants respectfully disagree.

Applicants submit that Inoue does not teach or suggest the relationship between the workpiece 11 and the worktable 10. The only mention of their relationship is that they are clamped together. See column 4, line 67 to column 5, line 1 of Inoue. Further, Applicants submit that the figures in Inoue are merely diagrammatic and show no technical detail of the contact between the electrode breakthrough region and the worktable. Thus, Applicants submit that Inoue does not teach or suggest a backing member positioned abutting a face of a work piece through which the electrode exits, and wherein the backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claims 1 and 6.

Applicants submit that Briffod does not remedy the deficiencies of Inoue. Briffod merely discloses that the workpiece 2 is mounted on the second slide 13. See column 2, lines 42-44 of Briffod. Briffod does not teach or suggest any details of the region in which the electrode exits the workpiece and how it interacts with the slide 13. Thus, Applicants submit that Briffod does not teach or suggest that the discrete backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claims 1 and 6.

Moreover, even if Inoue and Briffod were to have been combined as suggested by the Patent Office, the method and apparatus recited in claims 1 and 6 would not have been achieved. As discussed above, neither Inoue nor Briffod teach or suggest any technical details relating to the nature of the contact between the workpiece and the backing member (e.g., worktable).

For the foregoing reasons, Applicants submit that Inoue and/or Briffod, in combination or alone, do not teach or suggest all of the features recited in claims 1 and 6. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**C. Briffod in view of Inoue**

Claims 1, 6, 11 and 12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Briffod in view of Inoue. This rejection is respectfully traversed.

Claims 1 and 6 have been amended to incorporate the subject matter of claims 11 and 12, respectively.

As discussed above, Applicants submit that Briffod and/or Inoue, in combination or alone, do not teach or suggest any technical details relating the nature of the contact between the workpiece and the backing member (i.e., worktable). In other words, neither Briffod nor Inoue teach or suggest that the discrete backing member is positioned to span and abut the entire breakthrough region on the face of the work piece through which the electrode exits, as recited in claims 1 and 6.

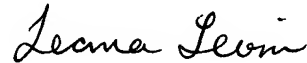
For the foregoing reasons, Applicants submit that Briffod and/or Inoue, in combination or alone, do not teach or suggest all of the features recited in claims 1 and 6. Reconsideration and withdrawal of the rejection are thus respectfully requested.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3 and 6-8 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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